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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,817	02/05/2001	John Michael Boushy	19538-05688	8587
758	7590	04/29/2005	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			SAGER, MARK ALAN	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/777,817

Applicant(s)

BOUSHY, JOHN MICHAEL

Examiner

M. A. Sager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Oct 21-22, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date Aug 18, 2003
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Information Disclosure Statement***

1. The information disclosure statement filed Oct 21, 2004 (Non-Confidential Documents) fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered. It is noted that the cover letter appeared to include a general listing; however, no 1449 or similar format containing the references being listed with application number listed on each page of the list, or column that provides a space next to each document to be considered, for the examiner's initials. In addition, many of the listed references lacked either date and/or pagination so as to discern whether the reference is prior art or whether the reference provided matched information to be considered (e.g. were all pages provided to be considered or has office received all pages that are to be considered for a particular reference). For instance, as an example and not only reference not meeting requirements under 37 CFR 1.98, second reference on bottom page 2, listed as Gaming Systems Int'l, "Gaming Management Solutions" brochure lacks space for initials, date, and pagination and the page upon which the reference was listed lacks identifying the application number.

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2. Regarding supplemental information disclosure statement filed Oct 22, 2004, material subject to protective order, the Office is in process of reviewing and is considering petition to expunge same; however, the Deposition transcript of Austin Miller (6/28/02) and Harrah's internal documentation re: Cross Property Card Specification, each listed on page 12 of cited IDS were not found in the provided files. Additionally, it is unclear from record why six CDS press releases listed on page 7 of cited IDS were identified as 'for attorneys eyes only', 'confidential' and under protective order when a press release is available to public view. Record does not indicate the listed press releases being internal documents (or is reference to aforementioned headings to confidential, etc. provide this information) nor does it indicate them to be 'proposed and not released' press releases.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1-8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This holding pertains to instant application. The originally filed specification herein fails to provide adequate written description including either a formula, method or algorithm or similar for a customer's theoretical win profile so as to reasonably convey to one of ordinary skill in the art that the inventor had possession of claimed invention regarding how the theoretical win profile is

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updated, generated, calculated, or determined including 'updating... theoretical win profile as a function of the... betting activity' (clm 1, 5-6) or 'receiving... theoretical win profile... gaming machines' (clm 2) or 'transmitting the theoretical win profile from the first database to the second database' (clm 2) or 'retrieving... theoretical win profile from the customer account associated with the input customer ID' (clm5) , 'a theoretical win profile generated... at any of the plurality of casino properties' (clm 4, 7), or 'to communicate to each other ... a customer's theoretical win profile' (clm 7), as claimed. *In re Gosteli*, 872 F.2d 1008, 1112 [10 USPQ2d 1614] (Fed Cir 1989). "Adequate description of the invention guards against the inventor's overreaching by insisting that he recount his invention in such detail that his future claims can be determined to be encompassed within his original creation." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1556 [19 USPQ2d 1111](Fe Cir 1991) (quoting *Rengo Co. v. Molins Mach. Co.*, 657 F.2d 535, 551 [211 USPQ2d 303] (3d. Cir 1981). Also, the written disclosure fails to differentiate a theoretical win from theoretical win profile.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1-8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This holding pertains to instant application. The claimed invention is indefinite for being unclear regarding updating, calculating, generating, or determining a customer's theoretical win profile from betting activity, as claimed, or is indefinite for failing to provide the metes and bounds of the invention in a manner to provide notice to the public of its scope. There is no claimed/disclosed formula, method, process or algorithm or similar to provide public notice

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of scope of claimed invention for calculating, determining or generating or updating a customer's theoretical win profile, as claimed. Further, a customer's theoretical win profile is a limitation purely defined by function such that it covers all means of achieving the function and thus appears to render the claim indefinite. *MDS Associates Limited Partnership v. the United States*, 37 Fed Cl 611, 625 (holding a claim indefinite for failing to disclose any means of calculating CPA Range and CPA Bearing using particular input signals). Facts in instant application similarly show failure to disclose any means of calculating, determining, generating or updating the function 'theoretical win profile'. A claim is indefinite if its scope is not clear enough that a person of ordinary skill in the art could determine whether a particular composition infringes or not. *Geneva Pharmaceuticals*, 349 F3d at 1384. Alternatively, there does not appear to be a differentiation between theoretical win and a customer's theoretical win profile so as to provide public notice.

### ***Response to Arguments***

7. Applicant's arguments with respect to claim 1-8 have been considered but are moot in view of the new ground(s) of rejection.

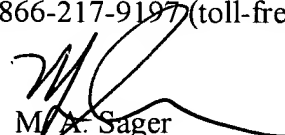
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M. A. Sager  
Primary Examiner  
Art Unit 3714

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